

#9
K Cooper
2-11-03

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS



In the Application of: Roy McGee) Date: January 30, 2003
Serial No.: 09/934,349) Group Art Unit: 3742
Filed: 08/21/2001) Examiner: Joseph Moore Pelham
Title: 12-Volt Heated Coffee Mug)

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on January 30, 2003 (date).

Signature

John D. Gugliotta

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)-872-9302 on January 30, 2003 (date).

Signature

John D. Gugliotta

SUPPLEMENTAL BRIEF ON APPEAL UNDER 37 C.F.R. 1.193

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

RECEIVED

FEB 10 2003

TECHNOLOGY CENTER R3700

New arguments made in the examiner's action of 10/30/02 are as follows:

1. Are claims 5-6 of the present invention anticipated as being obvious by Vaneslow in view of Gordon?

SUPPLEMENTAL ARGUMENT

The examiner respectfully rejected Claim 5-6 under 35 U.S.C. 103(a) as being unpatentable over Vaneslow in view of Gordon. Applicant incorporates by reference all

previous arguments as if fully rewritten herein.

It is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. The addition of the Gordon reference does not add to any suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of making heating element powered by a vehicle's electrical system for heating a conventional drinking mug in a manner that flexibly retains the mug in firm mechanical contact. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to

an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Further, in rejecting claims under 35 U.S.C. 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. 1993). A prima facie case of obviousness is established by presenting **evidence** that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Although many sources of suggestion are allowed, this requirement for actual evidence must be met with a clear and particular showing. See, e.g. C.R. Bard Inc. v. M3 Sys., Inc. 1527 F.3d 1340, 1352, 48 USPQ2d 1255, 1232 (Fed. Circ. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ 1614, 1617 (Fed. Cir. 1999).

To summarize, it appears that the examiner is holding us to a much different standard of obviousness than any of the other patent applications that have been cited as the relevant art. only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ

2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, the examiner's rejection of claims 2-3 under 35 U.S.C. 103(a) on obviousness grounds was improper. Most importantly there is no suggestion in any of the references for the combination proposed. If a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination.

Orthopedic Equipment, supra.

The claims as amended should therefore be allowable and the application be put in a condition for allowance. Accordingly, the reversal of the Examiner by the honorable Board of Appeals and entry of the supplemental amendment is respectfully solicited.

Respectfully submitted,

John D. Gugliotta, P.E., Esq.
Registration No. 36,538
Attorney for Appellant
202 Delaware Building
137 South Main Street
Akron, OH 44308
(330) 253-5678
Facsimile (330) 253-6658